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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/888,345	06/22/2001	Michael Gary Platner	030950.0004.UTL	8906
20985	7590	08/11/2004	EXAMINER	
FISH & RICHARDSON, PC 12390 EL CAMINO REAL SAN DIEGO, CA 92130-2081			RHODE JR, ROBERT E	
			ART UNIT	PAPER NUMBER
			3625	

DATE MAILED: 08/11/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/888,345

Applicant(s)

PLATNER ET AL.

Examiner

Rob Rhode

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-31 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-31 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 22 June 2004 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☒ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_.

## **DETAILED ACTION**

### ***Drawings***

The drawings filed on 6-22-01 are acceptable subject to correction of the informalities indicated on the attached "Notice of Draftperson's Patent Drawing Review," PTO-948. In order to avoid abandonment of this application, correction is required in reply to the Office action. The correction will not be held in abeyance.

### ***Specification***

The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**Claims 1 – 4, 6 – 15, 17 – 20 and 23 - 31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fortenberry (US 6,336,098 B1) in view of Kernahan (US 2002/0128903 A1).**

Regarding claims 1 and related claims 17 and 27, Fortenberry teaches a method comprising the steps of:

providing a plurality of certificates, each of said certificates comprising an authorization code, wherein said authorization code of each of said plurality of certificates is different (see at least Abstract, Col 4, lines 28 – 30 and Figure 3); obtaining a reduced fee for an online product by a purchaser, wherein said plurality of certificates are redeemable for said online product at said reduced fee; providing said plurality of certificates to said purchaser (see at least Col 3, lines 38 – 49 and Figure 3); providing one of said plurality of certificates to a user from said purchaser (see at least Figure 3); connecting by said user to a web site associated with said certificate over a system of networked computers (see at least Figure 3); paying a reduced fee for said online product by said user (see at least Col 4, lines 1 – 5); and obtaining said online product by said user in response to said step of paying (see at least Col 4, lines 1 – 5, Col 5, line 50 and Figures 2 & 3). Please note that Fortenberry does not specifically disclose certificates. However, Fortenberry does disclose coupons, which serve as a certificate connoting value. Thereby and for examination purposes, the examiner equates certificate with coupons.

Although Fortenberry does disclose coupons with individual and identifying serial numbers, the reference does not specifically disclose a method wherein said authorization code of each of said plurality of certificates is different. Nor does

Fortenberry specifically disclose a method of entering by said user said authorization code on said web site.

On the other hand, Kernahan in the same area of online coupons teaches a method wherein said authorization code of each of said plurality of certificates is different; and entering by said user said authorization code on said web site (see at least Para 101).

It would have been obvious to one of ordinary skill in the art to have provided the method of Fortenberry with the method of Kernahan to have enabled a method comprising the steps of: providing a plurality of certificates, each of said certificates comprising an authorization code, wherein said authorization code of each of said plurality of certificates is different; obtaining a reduced fee for an online product by a purchaser, wherein said plurality of certificates are redeemable for said online product at said reduced fee; providing said plurality of certificates to said purchaser; providing one of said plurality of certificates to a user from said purchaser; connecting by said user to a web site associated with said certificate over a system of networked computers; entering by said user said authorization code on said web site; paying a reduced fee for said online product by said user; and obtaining said online product by said user in response to said step of paying – in order to enable online transaction, while limiting fraud or to ensure privileges such as frequent flyers are protect.

Fortenberry discloses a method of providing a plurality of certificates, each of said certificates comprising an authorization code, wherein said authorization code of each

of said plurality of certificates is different; obtaining a reduced fee for an online product by a purchaser, wherein said plurality of certificates are redeemable for said online product at said reduced fee; providing said plurality of certificates to said purchaser; providing one of said plurality of certificates to a user from said purchaser; connecting by said user to a web site associated with said certificate over a system of networked computers; paying a reduced fee for said online product by said user; and obtaining said online product by said user in response to said step of paying (see at least Abstract, Col 4, lines 1 – 5, Col 5, line 50 and Figures 2 & 3). Kernahan disclose a method wherein said authorization code of each of said plurality of certificates is different; and entering by said user said authorization code on said web site (see at least Para 101). Therefore, one of ordinary skill in the art would have been motivated to extend the method of Fortenberry with a method wherein said authorization code of each of said plurality of certificates is different; and entering by said user said authorization code on said web site. In this manner, the privacy or the special offer for specific users would have been ensured. Thereby, increasing customer satisfaction, which will increase the probability that they will continue to use the online site as well as recommend the site to others.

Regarding claim 2 and related claim 19, the recitations that “wherein said online product comprise an online product related to the funeral industry”, such recitation is given little patentable weight because it imparts no structural or functional specificity

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which serves to patentably distinguish the instant invention from the other "products" already disclosed by Fortenberry as well as Kernahan.

Regarding claim 3 and please note that neither Fortenberry nor Kernahan specifically disclose a method wherein said certificate is sold to said user. However, it was old and well known to one of ordinary skill at the time of the invention that certificates such as coupons for travel with a partner were sold often by the airlines. Therefore, the user is willing to buy these coupons in order to obtain a reduced priced ticket for another individual such as buy one and get the next a half off.

Regarding claim 4 and related claims 8 and 9, Fortenberry teaches a method wherein certificate is given to said user at no charge (Col 5, lines 32 – 34).

Regarding claim 6, Fortenberry teaches a method wherein said certificate is not redeemable for cash (Col 6, line 17).

Regarding claim 7 and related claim 18, Kernahan teaches a method, wherein said certificate comprises a physical certificate (Para 004).

Regarding claim 10, Fortenberry teaches a method, wherein said certificate comprises a non-free certificate allowing said user to obtain said online product at a reduced fee (Figure 4).

Regarding claim 11 and related claims 12 and 23, the recitations "wherein said certificate allows said user to rent software via an application service provider for a specified time period" and "wherein said online product is an online service", such recitations are given little patentable weight because it imparts no structural or functional specificity which serves to patentably distinguish the instant invention from the other "products and services" already disclosed by Kernahan.

Regarding claim 13 and related claims 26 and related claim 31, Kernahan teaches a method, wherein said online product is customized to include information relating to said purchaser (Para 004). Please note that Kernahan does not specifically disclose customizing products online. Kernahan does disclose products. Moreover, it was old and well known to one of ordinary skill in the art at the time of the applicant's invention that online systems for customizing products such as for ecards. This customizing of products will increase customer satisfaction, which will increase the probability that the user will purchase more products.

Regarding claim 14, Fortenberry teaches a method, wherein a plurality of entities provide certificates to users and said online product is customized to reflect information relating to said entity (Col 6, lines 10 – 21).

Regarding claim 15, Kernahan teaches a method, wherein said authorization code is unique (Para 101).

Regarding claim 20, Kernahan teaches a method, further comprising giving said at least one of said plurality of certificates from said user to a second user (Para 0004). Please note that Kernahan does disclose a paper coupon for a user to use, and which can be given to another user as appropriate. Thereby, it would have been obvious to one of ordinary skill to have extended the method of Kernahan with a method of providing a certificate to another user – in order for other user to obtain the benefit.

Regarding claim 24, Kernahan teaches a method, wherein said authorization code is associated with characteristics of said purchaser (Para 101). Please note further that characteristics could include other meaning such as biometrics. Biometrics identifies a user based on physical characteristics such as fingerprints or facial features and even voice. In that regard, biometric techniques for identification purposes is old and well known at the time of the applicant's invention. These characteristics of user via biometrics techniques such as facial characteristics are used even in some online methods to ensure higher levels of security.

Regarding claim 25 and related claim 30, Fortenberry teaches a method wherein said online product is customized to include information relating to said purchaser (Col 1, line 23).

Regarding claim 28, Kernahan teaches a method, wherein said authorization code is associated with characteristics that are recorded for tracking purposes (Para 0042).

**Claims 5, 16 and 21 - 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of Fortenberry and Kernahan as applied to claims 1, 17 and 21 above, and further in view of Walker (US 2002/0178071 A1).**

The combination of Fortenberry and Kernahan disclose and teach substantially the applicant's invention.

However, the combination does not specifically disclose a method wherein said certificate is sold to a purchaser and said purchaser sells certificate to said user. Nor does the combination specifically disclose a method further comprising: providing a commission to said entity; purchasing a second online product by said user; and providing a second commission to said entity as well as wherein said second online product is the same as the first online product.

Regarding claim 5, Walker teaches a method wherein said certificate is sold to a purchaser and said purchaser sells certificate to said user (Abstract and Figure 1A). Please note that Walker does not specifically disclose reselling certificates such as coupons. However, Walker does disclose reselling products. In that regard, it would

have been obvious to one of ordinary skill in the art at the time of the invention to have provided the method of Walker with a method for reselling certificates such as coupons. In this manner, the purchaser can use these incentives to increase their sales.

Regarding claim 16 and related claim 21, Walker teaches a method, further comprising: providing a commission to said entity; purchasing a second online product by said user; and providing a second commission to said entity (Para 055).

Regarding claim 22, Walker teaches a method, wherein said second online product is the same as the first online product (Figure 1A).

It would have been obvious to one of ordinary skill in the art at the time of the invention to have provided the combination of Fortenberry and Kernahan with the method of Walker to have enabled a method wherein said certificate is sold to a purchaser and said purchaser sells certificate to said user; and further comprising: providing a commission to said entity; purchasing a second online product by said user; and providing a second commission to said entity as well as wherein said second online product is the same as the first online product – in order to provide additional offers of certificates such as coupons. The combination of Fortenberry and Kernahan disclose a method comprising the steps of: providing a plurality of certificates, each of said certificates comprising an authorization code, wherein said authorization code of each of said plurality of certificates is different; obtaining a reduced fee for an online product

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by a purchaser, wherein said plurality of certificates are redeemable for said online product at said reduced fee; providing said plurality of certificates to said purchaser; providing one of said plurality of certificates to a user from said purchaser; connecting by said user to a web site associated with said certificate over a system of networked computers; entering by said user said authorization code on said web site; paying a reduced fee for said online product by said user; and obtaining said online product by said user in response to said step of paying. Walker discloses in the same area of online methods with coupons a method wherein said certificate is sold to a purchaser and said purchaser sells certificate to said user and a method further comprising: providing a commission to said entity; purchasing a second online product by said user; and providing a second commission to said entity as well as wherein said second online product is the same as the first online product (Abstract, Para 055 and Figure 1A).

Therefore, one of ordinary skill in the art would have been motivated to extend the combination of Fortenberry and Kernahan with a method wherein said certificate is sold to a purchaser and said purchaser sells certificate to said user and a method further comprising: providing a commission to said entity; purchasing a second online product by said user; and providing a second commission to said entity as well as wherein said second online product is the same as the first online product.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Rob Rhode** whose telephone number is **(703) 305-8230**. The examiner can normally be reached Monday thru Friday 8:00 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, **Jeff Smith** can be reached on **(703) 308-3588**.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the **Receptionist** whose telephone number is **(703) 308-1113**.

Any response to this action should be mailed to:

***Commissioner for Patents***

***P.O. Box 1450***

**Alexandria, Va. 22313-1450**

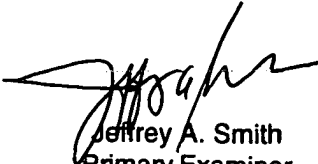
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Hand delivered responses should be brought to Crystal Park 5, 2451 Crystal Drive, Arlington, VA, 7<sup>th</sup> floor receptionist.

RER

  
Jeffrey A. Smith  
Primary Examiner